

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
ALLAN S. ALGAZI

Serial No.: 09/759,566

Filed: January 11, 2001

For: IMPROVED SYSTEM AND METHODS
FOR TRANSPORTATION AND
DELIVERY USING BAR CODES

Examiner: J. WEBB

Group Art Unit: 3629

Att'y Docket: 6000.001200

APPEAL BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby submits this Appeal Brief to the Board of Patent Appeals and Interferences in response to the final Office Action dated November 3, 2005. A Notice of Appeal for the above captioned patent application was filed February 22, 2006, so this Appeal Brief is believed to be timely filed.

Commissioner is authorized to deduct the fee for filing this Appeal Brief (\$500) from Williams, Morgan & Amerson's P.C. Deposit Account 50-0786/6000.001200.

I. REAL PARTY IN INTEREST

The present application is owned by Symbol Technologies, Inc. The assignment of the present application to Symbol Technologies, Inc., is recorded at Reel 11471, Frame 0097.

II. RELATED APPEALS AND INTERFERENCES

Applicant is not aware of any related appeals and/or interferences that might affect the outcome of this proceeding.

III. STATUS OF THE CLAIMS

Claims 1-41 are pending in the application. The claims as currently pending are attached as Appendix A. Claims 4-9, 16-21, and 24-41 have been withdrawn from consideration. Claims 1-2, 10-11, 13-14, and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Recktenwald, *et al.* (U.S. Patent No. 6,439,345) in view of Berson (U.S. Patent No. 6,802,005). Claims 3 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Berson in view of Stephens, *et al.* (U.S. Patent No. 6,323,782). Claims 12 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Berson in view of Keagy, *et al.* (U.S. Patent No. 6,069,969).

IV. STATUS OF AMENDMENTS

There were no amendments after the final rejections.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The Internet has produced a proliferation of e-commerce transactions, at least in part because e-commerce transactions offer convenience and speed to customers seeking to purchase goods online. Most e-commerce transactions end with the physical delivery of goods to a customer. However, the delivery stage is particularly prone to error and/or sabotage and goods purchased online may be inadvertently or maliciously routed to the wrong destination.

The present invention provides an improved method for the handling and delivery of packages and other e-commerce transactions using the security features available in two-dimensional bar codes. Two-dimensional bar codes have been developed to encode more information in a smaller space. Where traditional one-dimensional bar codes act as a pointer to reference information stored in a database, two-dimensional bar codes can function as the database itself and therefore insure complete portability for two-dimensional label items. For example, Portable Data File 417 (PDF417) is a two-dimensional stacked bar code symbology capable of encoding over a kilobyte of data per label. See Patent Application, page 4, ll. 9-17. Examples of two-dimensional barcodes are shown in Figures 2, 4, and 4A of the Patent Application.

Two-dimensional bar codes may be used as a key to access information. For example, a consumer desiring information or goods from a provider may present a barcode previously obtained from the provider that encodes information about the consumer that only the consumer can verify. If the provider matches the information from the barcode with the information provided by the consumer, the provider can allow access to the desired information or goods without fear that a fraud or mistake has taken place. The encoded information may include

biometric data such as facial appearance, signatures, thumb prints, handprints, voice prints, retinal scans, and the like.

In particular, claim 1 sets forth a method of obtaining a package that includes notifying a user electronically that a package has arrived at a predetermined location and printing a paper receipt including a two-dimensional bar code encoding the user's previously provided biometric information. The two-dimensional bar code is scanned and decoded at the predetermined location to obtain the user's previously provided biometric information and conveying the user's current biometric information to a retrieval device. If the user's current biometric information is equivalent to the user's current biometric information, the package is provided to the user by the retrieval device.

Claim 13 sets forth an apparatus for delivering goods that includes a notifier for notifying a user electronically that a package has arrived at a predetermined location, a scanner for scanning a two-dimensional bar code provided by a user at the predetermined location, and a decoder for decoding the user's previously provided biometric information from the two-dimensional bar code. The apparatus also includes a collector for collecting the user's current biometric information, a comparator for comparing the user's current biometric information and the user's previously provided biometric information, and a provider for providing the package to the user if the user's current biometric information matches the user's previously provided biometric information.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests that the Board review and overturn the three rejections present in this case. The following issues are presented on appeal in this case:

(A) Whether claims 1-2, 10-11, 13-14, and 22 are obvious over Recktenwald in view of Berson;

(B) Whether claims 3 and 15 are unpatentable over Recktenwald and Berson and further in view of Stephens; and

(C) Whether claims 12 and 23 are unpatentable over Recktenwald and Berson and further in view of Keagy.

VII. ARGUMENT

A. Legal Standards

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

B. Claims 1-2, 10-11, 13-14, and 22 are not obvious over Recktenwald in view of Berson.

Recktenwald describes an item pick up system 100 that permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item when the item is not available on the sales floor or when the person must, or wishes to, pick up the item at a later time. See Recktenwald, col. 4, ll. 47-53 and Figure 1. The customer, or the customer's representative, may use a barcode scanner 200 of a kiosk 104 to scan a one-dimensional barcode from a sales check that was presented to the customer by a point-of-sale

register attendant at the time that the customer purchased the item. See Recktenwald, col. 6, ll. 58-63 and Figure 5. The item pick up system 100 then searches one or more databases to find the items associated with the scanned one-dimensional barcode from the sales check.

However, as admitted by the Examiner, Recktenwald does not describe or suggest the use of a two-dimensional barcode, as set forth in independent claims 1 and 13 of the present invention. Moreover, as admitted by the Examiner, Recktenwald does not describe or suggest scanning and decoding a barcode to obtain the user's previously provided biometric information, conveying the user's current biometric information to the retrieval device, and, if the user's current biometric information is equivalent to the user's previously provided biometric information, providing the package to the user, as set forth in independent claims 1 and 13 of the present invention.

To remedy at least the acknowledged deficiencies of the primary reference, the Examiner cites Berson, Keagy, and Stephens. Berson describes techniques for generating a card that includes a two-dimensional bar code, which represents encrypted biometric information associated with an employee. See Berson, col. 3, line 18 – col. 4, line 25. The card may be used to track the time the employee spends at a job site. Keagy describes using a two-dimensional barcode to encode information extracted from a fingerprint to verify the identity of a user. Stephens describes transmitting information regarding item delivery via a radiofrequency transmission or a cell phone.

However, Applicant respectfully submits that the cited references provided no suggestion or motivation to combine the teachings of the primary reference with the teachings of one or more of the secondary references to arrive at Applicant's claimed invention. In particular, Applicant submit that neither Recktenwald nor Berson provide any suggestion or motivation to

combine the card including the two-dimensional bar code described by Berson and the package retrieval system described by Recktenwald. To the contrary, Recktenwald teaches away from the Examiner's proposed modifications.

The item pick up system described by Recktenwald permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item. Thus, Applicant respectfully submits that Recktenwald appears to teach away from any method that associates a particular person with the sales check. For example, Recktenwald teaches away from imprinting the sales check with a two-dimensional bar code that represents biometric information associated with the person who purchased the item because this would not allow other non-employee persons acting for the customer, such as a relative or friend, to pick up the purchased item. Thus, Recktenwald teaches away from scanning and decoding the two-dimensional barcode to obtain the user's previously provided biometric information, conveying the user's current biometric information to the retrieval device, and, if the user's current biometric information is equivalent to the user's previously provided biometric information, providing the package to the user, as set forth in independent claims 1 and 13 of the present invention.

In response to this argument, the Examiner states that Recktenwald does not require that a person other than the customer pick up a purchased item. The Examiner therefore alleges that Recktenwald does not teach away from the Examiner's proposed modification because the customer could pick up the purchased item. Applicant respectfully disagrees and notes that whether or not the customer may pick up the purchased item is not relevant to determining whether or not Recktenwald teaches away from the present invention. As discussed above, and as admitted by the Examiner at item 11 on page 4 of the Final Office Action, Recktenwald teaches that it is a possibility that someone other than the customer may pick up the purchased

item. Applicant submits that the possibility that someone other than the customer may pick up the purchased item implies that biometric information associated with the customer should not be used to identify the person picking up the purchased item. Consequently, as also admitted by the Examiner, Recktenwald teaches that a customer identification number (*i.e.*, information that may be passed from the customer to an authorized person, unlike biometric information) may be used to verify the person picking up the purchased item.

For at least these reasons, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 1-2, 10-11, 13-14, and 22 are obvious over Recktenwald in view of Berson. Appellants respectfully request that the Examiner's rejection of claims 1-2, 10-11, 13-14, and 22 be REVERSED.

C. Claims 3 and 15 are not obvious over Recktenwald and Berson and further in view of Stephens.

Claims 3 and 15 depend from independent claims 1 and 13, respectively. Claims 3 and 15 set forth, in addition to the limitations set forth in the independent claims, notifying a user electronically occurs via a cell phone. Stephens describes notifying a customer via a cell phone when an item is ready for pickup. However, Stephens fails to remedy the aforementioned fundamental deficiencies in Recktenwald and Berson with regard to independent claims 1 and 13.

For at least this reason, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 3 and 15 are obvious over Recktenwald in view of Berson and further in view of Stephens. Appellants respectfully request that the Examiner's rejection of claims 3 and 15 be REVERSED.

D. Claims 12 and 23 are not obvious over Recktenwald and Berson and further in view of Keagy.

Claims 12 and 23 depend from independent claims 1 and 13, respectively. Claims 12 and 23 set forth, in addition to the limitations set forth in the independent claims, a two-dimensional bar code that utilizes the PDF417 symbology. Keagy describes a two-dimensional bar code formed according to the PDF417 symbology. However, the prior art of record provides no suggestion or motivation to combine the teaching of Keagy with Recktenwald and Berson. To the contrary, Recktenwald teaches away from using a two-dimensional bar code. In particular, Recktenwald teaches scanning a one-dimensional barcode and using the scanned one-dimensional barcode as a pointer to one or more databases to find the items associated with the scanned one-dimensional barcode. See Recktenwald, col. 6, ll. 58-63 and Figure 5.

Keagy also fails to remedy other deficiencies with Recktenwald and Berson. In particular, Keagy does not address Recktenwald's teaching away from verifying that the person holding the sales check including the scanned one-dimensional barcode is the person who purchased the item, as discussed above.

For at least this reason, Appellants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 12 and 23 are obvious over Recktenwald in view of Berson and further in view of Keagy. Appellants respectfully request that the Examiner's rejection of claims 12 and 23 be REVERSED.

VII. CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application, claims 1-3, 10-15, and 22-23, over the prior art of record. The undersigned may be contacted at (713) 934-4070 with respect to any questions, comments or suggestions relating to this appeal.

Respectfully submitted,

Date: _____

Scott F. Diring
Reg. No. 35,119
WILLIAMS, MORGAN & AMERSON
10333 Richmond, Suite 1100
Houston, Texas 77042
(713) 934-7000
(713) 934-7011 (facsimile)

ATTORNEY FOR APPLICANTS

APPENDIX A

1. (PREVIOUSLY PRESENTED) A method of obtaining a package, comprising:
notifying a user electronically that a package has arrived at a predetermined location;
printing a paper receipt including a two-dimensional bar code encoding a user's
previously provided biometric information;
at the predetermined location, scanning the two-dimensional bar code, decoding the two-dimensional bar code to obtain the user's previously provided biometric information and conveying a user's current biometric information to a retrieval device; and
if the user's current biometric information is equivalent to the user's previously provided biometric information, providing the package to the user by the retrieval device.
2. (ORIGINAL) The method of claim 1, further comprising:
presenting the package for visual inspection by the user prior to providing the package to the user by the retrieval device.
3. (ORIGINAL) The method of claim 2, wherein the step of notifying a user electronically occurs via a cell phone.
4. (WITHDRAWN) The method of claim 2, wherein the step of notifying a user electronically occurs via a PDA.
5. (WITHDRAWN) The method of claim 2, wherein the step of notifying a user electronically occurs via a two-way pager.

6. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's fingerprint.

7. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's 10 handprint.

8. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's voiceprint.

9. (WITHDRAWN) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's facial features.

10. (ORIGINAL) The method of claim 2, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's signature.

11. (ORIGINAL) The method of claim 10, wherein conveying the user's current biometric information is accomplished by:

affixing the user's signature to a signature bar code; and
scanning the signature bar code.

12. (ORIGINAL) The method of claim 2, wherein the two-dimensional bar code utilizes the PDF 417 symbology.

13. (PREVIOUSLY PRESENTED) An apparatus for delivering goods, comprising:
a notifier for notifying a user electronically that a package has arrived at a predetermined location;

a scanner for scanning a two-dimensional bar code provided by a user at the predetermined location;

a decoder for decoding a user's previously provided biometric information from the two-dimensional bar code;

a collector for collecting a user's current biometric information;

a comparator for comparing the user's current biometric information and the user's previously provided biometric information; and

a provider for providing the package to the user if the user's current biometric information matches the user's previously provided biometric information.

14. (ORIGINAL) The apparatus of claim 13, further comprising:

a presenter for presenting the package for visual inspection by the user prior to providing the package to the user by the provider.

15. (ORIGINAL) The apparatus of claim 14, wherein the notifier operates via a cell phone.

16. (WITHDRAWN) The apparatus of claim 14, wherein the notifier operates via a PDA.

17. (WITHDRAWN) The apparatus of claim 14, wherein the notifier operates via a two-way pager.

18. (WITHDRAWN) The apparatus of claim 14, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's fingerprint.

19. (WITHDRAWN) The apparatus of claim 14, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's handprint.

20. (WITHDRAWN) The apparatus of claim 14, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's voiceprint.

21. (WITHDRAWN) The apparatus of claim 13, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's facial features.

22. (ORIGINAL) The apparatus of claim 14, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's signature.

23. (ORIGINAL) The apparatus of claim 14, wherein the two-dimensional bar code utilizes the PDF 417 symbology.

24. (WITHDRAWN) A method of establishing a service for package delivery, comprising:

a user providing to a service provider select biometric information, select contact information, and select financial information in a secure fashion;

insuring that the select financial information and the select biometric information are stored in a secure manner apart from the select contact information; and

encoding the select biometric information so as to be capable of being printed in a two-dimensional bar code.

25. (WITHDRAWN) The method as in claim 24, further comprising:
the user ordering a package from a package provider and directing the provider to send the package to the service provider;

the package provider contacting the service provider to obtain the user's select contact information;

the service provider notifying the user electronically that the package has arrived at a predetermined location.

26. (WITHDRAWN) The method of claim 25, wherein the step of the user ordering a package is accomplished via the Internet.

27. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's facial features.

28. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's voiceprint.

29. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's fingerprint.

30. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's signature.

31. (WITHDRAWN) The method of claim 25, wherein the select biometric information include data related to the user's handprint.

32. (WITHDRAWN) A method of returning a package, comprising
a user notifying a package provider that the user desires to return a package to the
package provider via a service provider;
after consultation with the package provider, the service provider notifying the user
electronically that the package is ready to be accepted for return;
printing a paper return label including a two-dimensional bar code encoding the user's
previously provided biometric information;
affixing the paper return label to the package;
at the predetermined location, scanning the two-dimensional bar code, decoding the two-
dimensional bar code to obtain the user's previously provided biometric
information and conveying the user's current biometric information to a deposit device;
if the user's current biometric information is equivalent to the user's current biometric
information, the user providing the package to the service provider by the deposit device; and
the service provider providing the package to the package provider.

33. (WITHDRAWN) The method as in claim 32, further comprising:
querying the user the reason for returning the package.

34. (WITHDRAWN) The method as in claim 33, further comprising:
ascertaining the current physical dimension and weight parameters of the package by the
deposit device and comparing the current physical dimension and weight parameters of the

package with previously established physical dimension and weight 15 parameters provided by the package provider; and

if the current physical dimension and weight parameters are substantially equivalent to the previously established physical dimension and weight parameters, accepting the package by the service provider and crediting the user's financial account by the package provider for the amount spent on the package.

35. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric

information and the user's current biometric information include data related to the user's fingerprint.

36. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's handprint.

37. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's voiceprint.

38. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's facial features.

39. (WITHDRAWN) The method of claim 34, wherein the user's previously provided biometric information and the user's current biometric information include data related to the user's signature.

40. (WITHDRAWN) The method of claim 34, wherein the two-dimensional bar code utilizes the PDF 417 symbology.

41. (WITHDRAWN) The method of claim 34, wherein the step of the user notifying the package, provider is accomplished via the Internet.